

## REMARKS

The Office Action mailed December 16, 2004, has been received and reviewed. Claims 1-27 are currently pending in the application. Claims 1-8, 10-17, 21, 24, 26, and 27 stand rejected. Applicants propose canceling claim 14. Applicants propose to amend claims 1-4, 6, 9, 10, 13, 15-27, and respectfully request reconsideration of the application as proposed to be amended herein.

### Claim Objections Based on Informalities

Claims 2-4, 6, 9, 10, 13, 16-24, and 26 were objected to because of the following informalities, for purposes of better reading of the claims, it was suggested to applicant to make the following amendments:

In claim 2 line 2 delete the second occurrence of "the".

In claim 3 line 1 delete "said".

In claim 4 line 2 delete "said".

In claim 6 line 1 replace "1" with -5-.

In claim 9 line 6 delete "the".

In claim 10 line 1 replace "8" with -9-.

In claim 13 replace "11" with -12-.

In claim 16 line 1 replace "14" with -15-.

In claim 17 line 1 replace "1" with -15-.

In claim 18 line 1 replace "1" with -15—and "the slot" with -a slot-.

In claim 19 in line 1 replace "1" with -15—in line 3 delete "said".

In claim 20 line 1 replace "1" with -15—and "said matched filter" with -a matched filter-, delete the second occurrence of "said", in line 2 delete "said".

In claim 21 line 3 delete ",", and replace "the selected portion" with -a selected portion-.

In claim 22 line 1 replace "said secondary" with -a secondary-, in line 3 replace "the first" with -a first-.

In claim 23 line 1 replace "21" with -22-.

In claim 24 line 1 insert “a” before –pilot–, in line 2 delete “the”.

In claim 26 line 1 replace “a pilot” with –said pilot–.

Appropriate correction is required. (Office Action, pp. 2-3).

Accordingly, Applicants, in an effort to expedite prosecution and comply with the Examiner’s request herein, have amended the claims as requested by the Examiner, with additional modifications and additions to the Examiner’s recommendations to make the claims more readable and allowable in view of the Allowable Subject Matter as detailed by the Examiner in the Office Action.

Therefore, Applicants respectfully request that the objections be withdrawn and the claims passed to allowance.

### **35 U.S.C. § 102(b) Anticipation Rejections**

#### **Anticipation Rejection Based on Applicant’s Admitted Prior Art**

Claims 1-8, 11, 17-21, and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Admitted Prior Art. Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants submit that Applicant’s Admitted Prior Art does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of presently amended claims, because Applicant’s Admitted Prior Art does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

Applicants presently amended independent claim 1 from which claims 2-8 and 11 at least indirectly depend reads:

1. A method for receiving a signal, the method comprising:
  - sampling the received signal to produce a stream of received samples, the stream of received samples comprising a first set of received samples followed by a second set of received samples;
  - correlating said first set of received samples with a primary synchronization code to form a first slot timing estimate;
  - generating a second slot timing estimate based at least in part on said second set of received samples;
  - decoding a secondary synchronization code word based on said first slot timing estimate, said second slot timing estimate and said second set of received samples; and
  - testing a validity of the first slot timing estimate based on the second slot timing estimate to produce a slot timing validity.*** (Emphasis added.)

Without the need for detailing the disclosure of Applicant's Admitted Prior Art, the Office Action concedes that, at least, the element/step of "***testing a validity of the first slot timing estimate based on the second slot timing estimate to produce a slot timing validity***" is allowable in view of any admitted or cited prior art. Specifically, the Office Action states:

Allowable Subject Matter

Claims 9, 18-20, 22-23, 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (Office Action, p. 8).

Specifically, Applicant's objected to but allowable claim 25 includes the element "***for testing the validity of the first slot timing estimate based on the second slot timing estimate to produce a slot timing validity***" that is not taught in Applicant's Admitted Prior Art. Therefore, presently amended independent claim 1, and claims 2-8 and 11 depending therefrom, are not anticipate by Applicant's Admitted Prior Art under 35 U.S.C. § 102. Accordingly, such claims are allowable over the cited art and Applicants respectfully request that such rejection be withdrawn.

Regarding claims 17 and 21, these claims have been amended to depend from objected to claim 25 which has been rewritten in independent form. Therefore, Applicants respectfully request that the rejections be withdrawn.

Regarding claims 18-20, claims 18, 19, and 20 were objected to but have been rewritten in independent form including all of the limitations of any base claims. Therefore, Applicants respectfully request that the rejection be withdrawn.

Regarding claim 27, Applicants presently amended independent claim 27 includes a similar element deemed by the Examiner as allowable although objected to in claim 25. Specifically, amended claim 27 includes a claim element drawn to a “means for testing the validity of the first slot timing estimate based on the second slot timing estimate to produce a slot timing validity”. Therefore, Applicants respectfully maintain that presently amended independent claim 27 is not anticipated by Applicant’s Admitted Prior Art under 35 U.S.C. § 102. Accordingly, such claim is allowable over the cited art. Applicants respectfully request that such a rejection be withdrawn.

### 35 U.S.C. § 103(a) Obviousness Rejections

#### Obviousness Rejection Based on Admitted Prior Art in view of U.S. Patent No. 6,754,251 to Sriram et al.

Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant’s Admitted Prior Art in view of Sriram et al. (U.S. Patent No. 6,754,251).

Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejection of claims 12 and 13 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding claim 12 and claim 13, depending from claim 12, which depends from presently amended independent claim 1, Applicants sustain the above-proffered arguments that Applicant’s Admitted Prior Art does not teach, disclose or motivate Applicants’ invention as claimed in amended independent claim 1 which includes elements deemed allowable by the

Examiner in the Office Action in view of the cited references. The Office Action introduces the Sriram reference and alleges:

The prior art did not specifically disclose wherein said measuring utilizes a soft decision block decoding technique, as in claim 12; wherein said soft decision block decoding technique utilizes the Chase algorithm, as in claim 13. US patent No. 6,754,251 (Sriram et al) discloses Spread Spectrum telephony with accelerated code acquisition wherein measuring is performed using digital matched filtering (Background col lines 28-30), as in claim 10; wherein said measuring utilizes a soft decision block decoding technique (soft decision decoding, col 6 line 46), as in claim 12. (Office Action, pp. 6-7)

Even assuming arguendo, that the Sriram reference teaches as alleged, neither Applicant's Admitted Prior Art nor Sriram teach, disclose or motivate Applicants' invention as claimed in independent claim 1 from which claims 12 and 13 depend namely:

1. A method for receiving a signal, the method comprising:
  - sampling the received signal to produce a stream of received samples, the stream of received samples comprising a first set of received samples followed by a second set of received samples;
  - correlating said first set of received samples with a primary synchronization code to form a first slot timing estimate;
  - generating a second slot timing estimate based at least in part on said second set of received samples;
  - decoding a secondary synchronization code word based on said first slot timing estimate, said second slot timing estimate and said second set of received samples; and
  - testing a validity of the first slot timing estimate based on the second slot timing estimate to produce a slot timing validity.*** (Emphasis added.)

Therefore, Applicants respectfully request that the rejection of dependent claims 12 and 13 be withdrawn.

Obviousness Rejection Based on Admitted Prior Art in view of Wheatley

Claims 10, 24 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art in view of Wheatley. Applicants respectfully traverse this rejection, as hereinafter set forth. The Office Action specifically listed claims 9, and 25 as being objected to but allowable if rewritten in independent form including any intervening claims. Applicants have amended claims 9 and 25 into independent from including any intervening claims.

The allowability and hence nonobviousness of independent claim 9 precludes a rejection of claim 10 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. Similarly, the allowability and hence nonobviousness of independent claim 25 precludes a rejection of claims 24 and 26 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to dependent claims 10, 24, and 26 which depend directly from presently amended and now-allowable independent claims 9 and 25.

#### **Allowable Subject Matter**

Claims 9, 18-20, 22-23, and 25 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Accordingly, Applicants have amended claims 9, 18-20, 22-23, and 25 into independent form. Applicants respectfully request the objections be withdrawn and the claims allowed.

**ENTRY OF AMENDMENTS**

Applicants propose to cancel claim 14 without prejudice. The proposed amendments to claims 1-4, 6, 9, 10, 13, 15-27 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search.

**REQUEST FOR ALLOWANCE**

In view of the foregoing, Applicants submit that claims 1-13 and 15-27 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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